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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,374	08/08/2007	Torsten Ziser	CH-8232/RC-235	2733

7590 10/02/2009  
Jennifer R. Seng  
Lanxess Corporation  
Law & Intellectual Property Department  
111 RIDC Park West Drive  
Pittsburgh, PA 15275-1112

EXAMINER
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WANG, CHUN CHENG

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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10/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,374	<b>Applicant(s)</b> ZISER ET AL.	
	<b>Examiner</b> Chun-Cheng Wang	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,9-18 and 21-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,9-18 and 21-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/28/2009 has been entered.
2. Claims 5, 7-8 and 19-20 have been cancelled. Claims 40 and 41 have been added. Claims 1-4, 6, 9-18 and 21-41 are pending now.

### ***Drawings***

3. The drawings are objected to because Figure number missing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

Art Unit: 1796

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The drawing identified as Fig. 1 should be filed in a separate sheet as drawing under 37 CFR 1.81(c).
5. The section (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S) is missing.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1-4, 6, 9-18, 21-23, 25-33 and 35-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Obrecht et al. (US 6399706).

The rejections stand as per the reasons set forth in paragraph 8 of the previous Office Action, incorporated herein by reference.

Regarding the added limitations in claim 1: Obrecht et al. disclose 250 mg microgel is allowed to swell in 25 ml of toluene (column 3, lines 12-15). Obrecht et al. disclose non-hydroxyl-modified SBR microgel having a diameter of  $d_{10} = 50$  nm,  $d_{50} = 56$  nm and  $d_{80} = 60$  nm (EXAMPLE 1), which has diameter deviation of 20% ( $= (60-50)/50 \times 100$ ).

Regarding the newly added claims 40-41: Obrecht et al. disclose 250 mg microgel is allowed to swell in 25 ml of toluene (column 3, lines 12-15).

***Claim Rejections - 35 USC § 102/103***

Art Unit: 1796

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 24 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Obrecht et al. (US 6399706).

The rejections stand as per the reasons set forth in paragraph 10 of the previous Office Action, incorporated herein by reference.

10. Claims 1-4, 6, 12, 14, 16, 18, 21-24, 27-28, 30, 33-37 and 40-41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamamoto et al. (US 6548454).

The rejections stand as per the reasons set forth in paragraph 11 of the previous Office Action, incorporated herein by reference.

Regarding newly added limitations in Claim 1: Yamamoto et al. is silent on the deviation of the particle diameters. Yamamoto et al. further disclose “if the average particle diameter of the ultrafine particulate organic material falls below the above defined lower limit, agglomeration of powder particles occurs to produce a secondary particle that causes deteriorated dispersibility when mixed with the base oil and other components to prepare a lubricant composition. On the contrary, if the average particle diameter of the ultrafine particulate organic material exceeds the above defined upper limit, the powder sparingly enter into the rolling contact surface or sliding contact surface or can be caught by these surfaces to drastically increase the torque of the rolling apparatus, possibly disabling the rolling apparatus” (column 16, lines 48-60). Since the reference discloses controlling the size of the ultrafine particulate organic material, one ordinary skilled

Art Unit: 1796

would anticipated the ultrafine particulate organic material has the claimed particle size deviation.

“When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Regarding the newly added Claims 40-41: Yamamoto et al. disclose lubricant composition contains the ultrafine particulate organic material in an amount of 1 to 45% by weight and base oil in an amount of 55 to 95% by weight (column 2, lines 56-67 and column 3, lines 1-37). Yamamoto et al. also disclose the base oil is a liquid fluorinated polymer oil, such as perfluoropolyether (read on polyether oil), trifluoroethylene telomere and fluorosilicone polymer (read on silicon-containing oil) (column 10, lines 45-57).

### ***Response to Arguments***

11. Applicant's arguments filed 08/28/2009 have been fully considered but they are not persuasive.

Regarding rejections under 35 U.S.C. 102(b) anticipated by Obrecht et al (US 6399706): See paragraph 7.

Regarding rejections under 35 U.S.C. 102/103 over Yamamoto et al. (US 6548454): See paragraph 10. The base oil is liquid polymer oil such as perfluoropolyether or fluorosilicone polymer.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chun-Cheng Wang whose telephone number is (571)270-5459. The examiner can normally be reached on Monday to Friday w/alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ling-Siu Choi/  
Primary Examiner, Art Unit 1796

/Chun-Cheng Wang/  
Examiner, Art Unit 1796

/CCW/